

Application No.: 10/668,001

Docket No.: HO-P0211682

REMARKS

Claims 21-30 are pending in this application. Claim 21 has been amended and claim 22 canceled without acquiescence and without prejudice to clearly define the scope of the invention. Support for the amendment can be found throughout the specification, more specifically, in the original claims. No new matter has been added.

This issues outstanding are as follows:

- Claims 21-27 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Baasiouny et al.
- Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Aga et al., US Patent 5,922,324.
- Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Scaglione et al., US Patent 5,000,973 in view of Nabi et al., US Patent 5,472,684.

Applicants respectfully traverse the outstanding rejections and objections, and Applicants respectfully request reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

## I. 35 U.S.C. §102(b)

Claims 21-27 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Baasiouny et al. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Anticipation of a claim is only established where "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

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In order to advance prosecution of the present invention, Applicants have amended independent claim 21 without prejudice and without acquiescence to indicate that at least 40 ppm of a plant extract is added.

The plant extracts used by Baasiouny et al. are the ether extracts. Of these ether extracts, the plant extracts are added at 0.02% into the shortening, and the shortening constitutes less than 10% of the overall dough, making the concentration of plant extracts in the dough of 0.001434% (14 ppm), as stated towards the bottom of page 299. Thus, Baasiouny et al. does not teach all the limitations of the claims.

In addition to the ether extracts used by Baasiouny et al., plant materials, not plant extracts, were used. As indicated on page 298, under Materials and Methods, plants were air-dried and knocked to isolate the leaves and the flowering tops, which were then ground to a fine powder. Thus, these plant materials do not fall under the scope of "plant extracts" as defined by the present application on page 5, lines 1-5, which states a plant extract is:

Any substance which is derived, obtained or extracted from a plant or plant part by conventional separation techniques.

As known by one of skill in the art, conventional separation techniques involve the use of a solvent, such as water or alcohol. Thus, the grinding of plant materials does not equate to an extraction process.

In view of the newly amended claim 21, Applicants assert that the Bassiouny et al. does not contain all the limitations of independent claim 21 and thus the rejection should be withdrawn.

## II. 35 U.S.C. §103(a)

### A. Aga et al., US Patent 5,922,324

Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Aga et al., US Patent 5,922,324. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

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As established by *In re Royka*, *prima facie* obviousness of a claimed invention can only be established if all the claim limitations are taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that all the claimed limitations are taught or suggested by the cited reference. Aga teaches that propolis is a resin-like product that is stored by bees in beehives.

Applicants define on page 5, lines 1-5 of the instant application the term plant ~~extract~~ to refer to:

Any substance which is derived, obtained or extracted from a plant or plant part by conventional separation techniques.

As taught by Aga et al. and known by those of skill in the art, propolis does not fall under the scope of this definition. Propolis is not made by conventional separation techniques of plant materials; propolis is made by bees collecting plant material. Thus, this type of extract is not similar to a "plant extract" as defined in the instant application. Yet further, nowhere in Aga et al. that the Applicants can identify, is there any suggestion that propolis is a plant extract as defined by the instant application. If the Examiner continues to maintain that Aga et al. is the basis for this rejection, the Examiner is requested to make of record the passage relied upon, or state for the record that no such teaching can be found in Aga et al. See, *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

Applicants also assert that Aga does not suggest that propolis can be substituted for a plant extract. One of skill in the art would not have been motivated to substitute propolis for a plant extract. Thus, with the lack of teaching or suggestion to produce a breath-freshening pet food containing a plant extract, Applicants assert that the Aga reference does not meet the basic requirements of a *prima facie* case of obvious.

**B. Scaglione US Patent No. 5,000,973 in view of Nabi US Patent 5,472,684**

Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Scaglione et al., US Patent No. 5,000,973, in view of CFR, title 21, Part 101, Subpart B, Sec. 101.22, in further view of Nabi et al., US Patent 5,472,684. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

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Applicants assert that the Examiner has not established a *prima facie* case of obviousness to reject the claims under 35 U.S.C. 103(a). *In re Vaeck*, 947 F.2d 481, 483, USPQ2d 1438, (Fed. Cir. 1991). A *prima facie* case necessitates disclosure of the source, either a suggestion or motivation to modify this reference to produce the present invention, and a reasonable expectation of success of producing the present invention.

Scaglione teaches a dog biscuit comprising phyrophosphate. Table 2 and Table 5 of Scaglione does mention that the biscuit can contain natural flavorants, however, it is not taught what these flavorants are or the purpose of adding the flavorants. Thus, one of ordinary skill would assume that the natural flavorants are merely added for the purpose of flavoring, not for reducing malodor. Still further, the dog biscuit referred to by Scaglione contains phyrophosphate to prevent and/or reduce tartar. One of skill in the art is aware that tartar (calculus) is plaque that has hardened by a process called calcification. The phyrophosphate in the dog biscuit reduces calcification thereby reducing tartar formation. This mechanism of reducing tartar formation does not correlate or relate to reducing malodor in pets by using plant extracts. Thus, the purpose of the dog biscuit of Scaglione is not to reduce malodor, but to reduce tartar formation.

The Examiner has combined CFR Title 21 with Scaglione to indicate a list of natural flavorants. Once again, Applicants assert that CFR Title 21 does not correct the defects of Scaglione in that CFR Title 21 does not teach or suggest that the natural flavorants are added to reduce malodor nor does CFR Title 21 indicate which natural flavorants could be used to reduce oral malodor, thus the combination of Scaglione and CFR Title 21 does not teach or suggest all the limitations of the present invention. Still further, the Examiner has added Nabia because Nabia teaches mouth washes/rinses, toothpaste, or gum having tea tree oil and eucalyptus to enhance antiplaque and antigingivitis activity, however, Nabia does not teach or suggest a breath-freshening pet food composition which reduces malodor in a pet.

Applicants respectfully remind the Examiner that section 103 requires consideration of the claimed invention "as a whole." This "as a whole" requirement prevents evaluation of the invention part by part, in hindsight. *Envil. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983). Without this requirement, an obviousness assessment could break an invention into its component parts, then find a prior art reference containing the component

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parts, and on that basis alone declare the invention obvious. The courts have refused to act on this type of hindsight reasoning, which uses the invention as a roadmap to find its prior art components. This type of analysis discounts the value of novel selection inventions. Thus, the courts have required that an Examiner must show some suggestion or motivation, excluding the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998); *In re Lee* 277 F.2d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002); and *c.f. Ruiz v. A.B. Chance Co.*, F.3d 1270 (Fed. Cir. 2004).

In view of the above arguments, Applicants assert that the combination of Scaglione, CFR Title 21 and Nabia does not teach all the claim limitations of the present invention, thus as Applicants respectfully request withdrawal of the rejection.

#### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10311777 from which the undersigned is authorized to draw.

Dated: March 9, 2005

Respectfully submitted,

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